



#7

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Siavash Fallahi *et al.*
Appl. No. 10/028,781
Filed: December 28, 2001
For: **IP Telephone System**

Confirmation No. 6416
Art Unit: 2817
Examiner: *To be Assigned*
Atty. Docket: 1875.1270001

Petition to Make Special Under 37 C.F.R. § 1.102(d)

**Attention: Group 2800
Special Program Examiner**

Commissioner for Patents
Washington, D.C. 20231

Sir:

This is a petition to the Assistant Commissioner to make the above-identified patent application special. The grounds and conditions for granting this application special status are found in M.P.E.P. § 708.02 VIII entitled "Special Examining Procedure for Certain New Applications - Accelerated Examination." The Petition Fee required pursuant to 37 C.F.R. § 1.17 is enclosed.

As provided for in M.P.E.P. § 708.02 VIII, Applicants agree to the special examining procedure detailed therein. This Petition is divided into the following sections:

- I. A statement that the claims are directed to a single invention.
- II. A description of a pre-examination search performed in connection with this application.
- III. A list of the documents uncovered by the pre-examination search and deemed most closely related to the subject matter encompassed by the claims.

RECEIVED
SEP 17 2002
TECHNOLOGY CENTER 2000

IV. A detailed discussion of the documents, pointing out, with the particularity required by 37 C.F.R. §§ 1.111(b) and 1.111(c), how the claimed subject matter is distinguishable over the documents.

V. Petition Fee.

VI. Conclusion.

I. *The Claims Are Directed To a Single Invention*

Claims 1-33 are pending in the application, and it is believed that these claims are directed to a single invention.

II. *Scope and Results of a Pre-examination Search*

The subject matter of the above-identified application relates to a communications device (e.g. Internet Protocol communication device). Applicants have not received an Office Action concerning the examination of the present application. A search was conducted by the International Searching Authority of the European Patent Office (EPO) in a counterpart international application filed under the Patent Cooperation Treaty (PCT), Intl. and given Appl. No. PCT/US01/50437. The claims in the PCT application are substantially identical to the pending claims in the present application. A copy of the International Search Report (PCT Form 210) is attached to this Petition. The search was conducted in the following field(s): IPC 7 H04M.(*See*, section B of the International Search Report) As stated in M.P.E.P. § 708.02: VIII (C), a search made by a foreign patent office satisfies the pre-examination search requirement. Therefore, the Applicants assert that this search

satisfies the pre-examination search requirement because it was performed by the European Patent Office in support of a corresponding PCT application with identical claims.

III. List of Documents Uncovered by the Pre-examination Search

The documents identified in the International Search Report are listed below, and copies of these documents are submitted herewith. All of these documents were also submitted in an Information Disclosure Statement for the present application that was filed on July 31, 2002. These documents are deemed most closely related to the subject matter encompassed by the claims that are known by the Applicants.

Applicants do not waive any rights to appropriate action to establish patentability over any of the listed documents should they be applied as references against the claims of the present application.

The International Search Report listed the following documents (References 1 to 4):

a) Foreign Patent Documents

1. WO 98/37665
2. WO 00/67452

b) Other Information and Publications

3. Hafer, R., "Designing Telephone-Interface Circuitry With Solid-State Relays," *Electronic Design*, 38:91-93 and 95-96, Penton Publishing, (December 1990)
4. Foo, S., *et al.*, "A Telephone Adapter For Internet Telephone Systems," *Microprocessors and Microsystems*, 21:213-221, IPC Business Press Ltd., (December 1997)

IV. Detailed Discussion of the Documents

The documents uncovered by the pre-examination search, and most closely related to the subject matter of the claims 1-33 are discussed below.

Reference 1: WO 98/37665

Reference 1 appears to be related to an Internet switch box that connects between a telephone set and a public switched telephone network (PSTN) line, where the PSTN can be used for telephone conversations and for connection to an Internet service provider (ISP). The Internet switch box contains hardware and software for establishing a connection to an ISP and for Internet telephony. The switch box is capable switching users engaged in telephone conversation over the PSTN to Internet telephony that is conducted via the ISP.

(Abstract)

However, reference 1 does not teach or suggest a communications device as recited in Applicants' claims. Considering claim 1, for example, Reference 1 does not teach or suggest a relay that is disposed on a substrate, and capable of being closed when zero volts is applied. Furthermore, reference 1 also does not teach a switchable termination resistor, disposed on the substrate, having an impedance capable of providing a termination for an external circuit coupled to the substrate.

Reference 2: WO 00/67452

Reference 2 appears to be related to a telephony adapter device connected to a public telephone network, a conventional telephone, and a computer, which allows the conventional telephone to be used for both traditional telephony and computer network telephony. The

adapter device includes a first connector connected to the telephone, a second connector connected to the public telephone network, and a third connector connected to the computer. The adapter device includes a signal processing circuitry electrically connected to the third connector. The adapter includes a separate switch connected to the first and second connectors and the signal processing circuitry. The switch electrically connects the first connector to the second connector in a first position. The switch electrically connects the first connector to the signal processing circuitry in a second position.(Abstract)

However, reference 2 does not teach or suggest a communications device as recited in Applicants' claims. Considering claim 1, for example, Reference 2 does not teach or suggest a relay that is disposed on a substrate, and capable of being closed when zero volts is applied.

Reference 3: Hafer, R., "Designing Telephone-Interface Circuitry With Solid-State Relays," *Electronic Design*, 38:91-93 and 95-96, Penton Publishing, (December 1990).

Reference 3 appears to be related to solid state relays ("SSR") used in telephone interface circuitry. Reference 3 explores various properties, applications, and design consideration for SSRs. For example, SSRs avoid contact bounce problems, arching, acoustic noise, and electromagnetic interference, which are all problems with mechanical switches.(Reference 3, page 91, col. 1) However, SSR designs require overvoltage protection to protect them from potential lighting damage, and are susceptible to overcurrent stresses. (Reference 3, page 91, col. 1)

However, Reference 3 does not teach or suggest a communications device as recited in Applicants' claims. Considering claim 1, for example, Reference 3 does not teach or

suggest a relay that is disposed on a substrate, and capable of being closed when zero volts is applied. Furthermore, Reference 3 also does not teach a switchable termination resistor, disposed on the substrate, having an impedance capable of providing a termination for an external circuit coupled to the substrate.

Reference 4: Foo, S., *et al.*, "A Telephone Adapter For Internet Telephone Systems," *Microprocessors and Microsystems*, 21:213-221, IPC Business Press Ltd., (December 1997)

Reference 4 appears to be related to an Internet telephone adapter ("ITA") device that is able to provide an interface between a conventional telephone and a host computer in order to enable Internet Telephony. The ITA enables users to dial an Internet telephone number to make a connection, be notified of an incoming call through ringing the telephone set, and carrying out the conversation using a conventional telephone handset. (Abstract)

However, Reference 4 does not teach or suggest a communications device as recited in Applicants' claims. Considering claim 1, for example, Reference 4 does not teach or suggest a relay that is disposed on a substrate, and capable of being closed when zero volts is applied. Furthermore, Reference 4 also does not teach a switchable termination resistor, disposed on a substrate, having an impedance capable of providing a termination for an external circuit coupled to the substrate.

V. Petition Fee

In accordance with the requirements of 37 C.F.R. § 1.102(d), Applicants submit herewith the Petition Fee of \$130.00 as required by 37 C.F.R. § 1.17. A check in that amount is enclosed.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

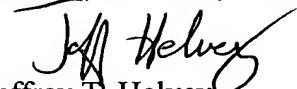
VI. Conclusion

Applicants respectfully submit that the requirements of 37 C.F.R. § 1.102 and M.P.E.P. § 708.02 pertaining to special status have been satisfied. Accordingly, it is respectfully requested that this Petition be granted.

This statement should not be construed as a representation that more material information, than that presented herein, does not exist. Furthermore, the submission of this material is not intended to displace the Examiner's professional ability and duty to search. Indeed, the Examiner is specifically requested not to rely solely on the materials submitted herewith. The Examiner is requested to conduct an independent and thorough review of the documents, and to form independent opinions as to their significance.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.


Jeffrey T. Helvey
Attorney for Applicants
Registration No. 44,757

Date: 9/13/02

1100 New York Avenue, N.W.
Suite 600
Washington, D.C. 20005-3934
(202) 371-2600
SKGF_DC1:48858.3



ATTORNEYS AT LAW

SEP 13 2002

PATENT & TRADEMARK OFFICE

Robert Greene Stern
Edward J. Kessler
Jorge A. Goldstein
David K.S. Cornwell
Robert W. Esmond
Tracy-Gene G. Durkin
Michele A. Cimbala
Michael B. Ray
Robert E. Sokohl
Eric K. Steffe
Michael Q. Lee
Steven R. Ludwig
John M. Covert
Linda E. Alcorn
Robert C. Millonig
Lawrence B. Bugalsky
Donald J. Featherstone
Michael V. Messinger

Judith U. Kim
Timothy J. Shea, Jr.
Patrick E. Garrett
Jeffery T. Helvey*
Heidi L. Kraus
Crystal D. Sayles
Edward W. Yee
Albert L. Ferro*
Donald R. Banowitz
Peter A. Jackman
Molly A. McCall
Teresa U. Medler
Jeffrey S. Weaver
Kendrick P. Patterson
Vincent L. Capuano
Albert J. Fasulo II*
Eldora Ellison Floyd
W. Russell Swindell

Thomas C. Fiala
Brian J. Del Buono
Virgil Lee Beaston*
Reginald D. Lucas
Kimberly N. Reddick
Theodore A. Wood
Elizabeth J. Haanes
Bruce E. Chalker
Joseph S. Ostroff
Frank R. Cottingham*
Christine M. Ohrler
Rae Lynn Prengaman*
Jane Shershenovich*
Lawrence J. Carroll*
George S. Bardmesser

Registered Patent Agents*
Karen R. Markowicz
Andrea J. Kamage
Nancy J. Leith
Joseph M. Conrad III
Amy E. Summerfield
Helene C. Carlson
Gaby L. Longsworth
Matthew J. Dowd
Aaron L. Schwartz
Angeline G. Uy
Boris A. Matveenko
Mary B. Tung
Katrina Y. Pei
Bryan L. Skelton
Jason D. Eisenberg
John J. Figueroa

Senior Counsel
Samuel L. Fox
Kenneth C. Bass III
Lisa A. Dunner

*Admitted only in Maryland
*Admitted only in Virginia
*Admitted only in Texas
•Practice Limited to Federal Agencies

September 13, 2002

WRITER'S DIRECT NUMBER:
(202) 371-2675

INTERNET ADDRESS:
JHELVY@SKGF.COM

Commissioner for Patents
Washington, D.C. 20231

Re: U.S. Design Patent Application
Appl. No. 10/028,781; Filed: December 28, 2001
Inventor(s): FALLAHI et al.
For: IP Telephone System
Our Ref: 1875.1270001

Sir:

Submitted herewith for appropriate action by the U.S. Patent and Trademark Office are the following documents:

1. Fee Transmittal Form (PTO/SB/17);
2. Petition to Make Special under 37 C.F.R. § 1.102(d);
3. **FIVE (5) Documents;**
4. Our Check No. 36654 for \$130.00 to cover the Petition to Make Special fee; and
5. One (1) Return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that the postcard be returned to our courier.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment to our Deposit Account No. 19-0036. If extensions of time under 37 C.F.R.

RECEIVED
SEP 17 2002
TECHNOLOGY CENTER 2800

Commissioner for Patents
September 13, 2002
Page 2

§ 1.136 are required to prevent abandonment of the present patent application, then such extensions of time are hereby petitioned, and any fees therefore are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Jeffrey T. Helvey
Attorney for Applicant
Registration No. 44,757

::ODMA\MHODMA\SKGF_DC1;55511;1
SKGF Rev. 2/15/02 dcw

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

SEP 13 2002

**FEE TRANSMITTAL
for FY 2002**

Patent fees are subject to annual revision.

Complete if Known

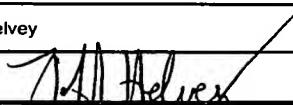
Application Number	10/028,781
Filing Date	December 28, 2001
First Named Inventor	FALLAHI et al.
Examiner Name	To Be Assigned
Group Art Unit	2817
Attorney Docket No.	1875.1270001

TOTAL AMOUNT OF PAYMENT \$130.00

METHOD OF PAYMENT (check one)		FEE CALCULATION (continued)					
1. <input type="checkbox"/> The Commissioner is hereby authorized to charge indicated fees and credit any overpayment to:		3. ADDITIONAL FEES					
Deposit Account Number	19-0036	Large Entity Fee Code (\$)	Fee (\$)	Small Entity Fee Code (\$)	Fee (\$)	Fee Description	
Deposit Account Name	Sterne, Kessler, Goldstein & Fox P.L.L.C.	105	130	205	65	Surcharge - late filing fee or oath	
<input checked="" type="checkbox"/> Charge Any Additional Fee Required Under 37 CFR §§ 1.16 and 1.17		127	50	227	25	Surcharge - late provisional filing fee or cover sheet	
<input type="checkbox"/> Applicant claims small entity status See 37 CFR 1.27		139	130	139	130	Non-English specification	
2. <input checked="" type="checkbox"/> Payment Enclosed:		147	2,520	147	2,520	For filing a request for ex parte reexamination	
<input checked="" type="checkbox"/> Check <input type="checkbox"/> Credit card <input type="checkbox"/> Money Order <input checked="" type="checkbox"/> Other*		112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
Charge any deficiencies or credit any overpayments in the fees or fee calculations of Parts 1, 2 and 3 below to Deposit Account No. 19-0036.		113	1,840	113	1,840*	Requesting publication of SIR after Examiner action	
FEE CALCULATION							
1. BASIC FILING FEE							
Large Entity Fee Code (\$)	Fee (\$)	Small Entity Fee Code (\$)	Fee (\$)	Fee Description		Fee Paid	
101	740	201	370	Utility filing fee			
106	330	206	165	Design filing fee			
107	510	207	255	Plant filing fee			
108	740	208	370	Reissue filing fee			
114	160	214	80	Provisional filing fee			
SUBTOTAL (1) (\$)		\$130.00					
2. EXTRA CLAIM FEES							
Extra	Fee from below	Fee Paid					
Total Claims 33	- 20** =	X _____ =					
Indep. Claims 5	- 3** =	X _____ =					
Multiple Dependent _____ = _____							
Large Entity Fee Code (\$)	Fee (\$)	Small Entity Fee Code (\$)	Fee (\$)	Fee Description			
103	18	203	9	Claims in excess of 20			
102	84	202	42	Independent claims in excess of 3			
104	280	204	140	Multiple dependent claim			
108	84	209	42	**Reissue independent claims over original patent			
110	18	210	9	**Reissue claims in excess of 20 and over original patent			
SUBTOTAL (2) (\$)		\$130.00					
** or number previously paid, if greater; For Reissues, see above							
*Reduced by Basic Filing Fee Paid							
SUBTOTAL (3) (\$ 130.00)							

SUBMITTED BY

Complete (if applicable)

Name (Print/Type)	Jeffrey T. Helvey	Registration No. (Attorney/Agent)	44,757	Telephone	202-371-2600
Signature			Date	9/13/02	

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.